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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,612

Applicant(s)

GUYAN ET AL. 

Examiner

Alain L. Bashore

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In view of the appeal brief filed on 2-24-04, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 29, 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "preferred" is vague and indefinite. What is preferred to one may not be preferred to another.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-14, 44-55 are rejected under 35 U.S.C. 101 as non-statutory because the method claims as presented do not claim a technological basis. Without a claimed basis, the claims are interpreted as involving no more than a manipulation outside of a technological art and therefore non-statutory under 35 U.S.C. 101.

In contrast, a method claim that includes in the preamble and body of the claim structural / functional interrelationships that are solely by computer (and non-trivial) are considered to have a technological basis and thus within the technological arts [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

Claims which are broad enough to read on statutory subject matter and on nonstatutory subject matter are considered nonstatutory [see In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972)].

Claims 15-28 are presumed to be apparatus claims and therefore not included in this rejection.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-9, 11-17, 19-23, 25-31, 33-37, and 39-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al in view of McLauchlin et al in further view of Murcko, Jr.

Borghesi et al discloses a method, system, and medium for evaluating line item data, including displaying at least one line item (e.g., Figures 6, 7, 9-12; column 2, line 50 et seq; column 3, line 5 et seq; column 6, line 15 et seq; column 7, line 40 et seq; column 8, line 50 et seq; column 19, line 6 et seq), selection of at least one line item from a claim handler (e.g., Figures 6, 7, 8E, 8G, 9-12; column 7, line 54 et seq; column 9, line 8 et seq; column 11, line 65 et seq; column 12, line 37 et seq; column 14, line 35 et seq; column 17, line 30 et seq; column 19, line 6 et seq; column 19, line 35 et seq), and receiving payment execution authorization (e.g., column 15, line 1 et seq), by direct payment (e.g., column 16, line 50 et seq), vendor transfer (e.g., total loss determination) (e.g., Figure 21; column 10, line 5 et seq; column 17, line 15 et seq; column 18, line 41 et seq; column 19, line 47 et seq), preauthorized payment (e.g., Figure 16; column 15, line 64 et seq; column 16, line 43 et seq), processor and memory (e.g., 26, 36) (Figure 2).

Borghesi et al also discloses receiving a direct payment amount (e.g., check) (e.g., column 16, line 50 et seq; column 18, line 52 et seq), back office communication (e.g., inherently disclosed), authorizing vendor transfer of authorized vendor database (e.g., Figures 8A-8L; column 10, line 57 et seq), deduction verification (e.g., column 9, lines 33-42), threshold amount (e.g., Figure 7; column 10, line 5 et seq; column 10, line 29 et seq), and date range (e.g., particular accident causing damage). The reference to Borghesi discloses insurance claims (col 1, lines 24-28). Item categories are disclosed (col 18, lines 50-51). The database of authorized vendors is disclosed as updated (col 14, lines 29-35).

Borghesi et al teaches accessing various databases of authorized vendors, displaying a list of authorized vendors that correspond with at least one line item, and accessing vendor data associated with the list of authorized vendors (col 12, lines 44-58). Each database inherently has a vendor and vendor data (including names of the vendors), and each vendor inherently is "authorized" (since it is in the computer).

Regarding upgrade availability, Borghesi et al discloses OEM parts which are an "upgrade" from recycled or salvaged parts (column 14, line 23 et seq)

Borghesi et al does not explicitly disclose:

receiving a selection of at least one vendor from the list of
authorized vendors; and

displaying a list of excluded vendors.

McLauchlin et al discloses vendors as authorized vendors (p 10, para 0142) and lists of excluded vendors (p 11, para 0163).

It would have been obvious to one with ordinary skill in the art to include receiving a selection of at least one vendor from the list of authorized vendors to Borghesi et al because McLauchlin et al teaches that preference types (non-profit, small, 8(a) etc...) of vendors may be utilized in the procurement determination process (p 10, para 0142).

It would have been obvious to one with ordinary skill in the art to include displaying a list of excluded vendors to Borghesi et al because McLauchlin et al teaches that certain types of vendors are excluded (debarred) from the procurement determination process (p 11, para 0163).

Both Borghesi and McLaughin et al are concerned with valuation of goods and services to be procured.

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Borghesi et al and McLauchlin et al do not disclose:

“preferred” vendors, vendor performance, payment only when “preferred” status;

correspondence with at least one line item regarding displaying of lists and authorizing a line item transaction;

line item payment authorization of receiving selection of at least one line item and form of payment and authorizing a transaction by EFT and check

date range for which payment will be made;

payment frequency and number of payments;

receiving new vendor identifying information, receiving vendor authorization data, and incorporating the new vendor into the database

Murcko, Jr discloses “preferred” (exceptional) vendors, vendor performance, payment only when “preferred” status (col 24, line 65), correspondence with at least one line item regarding displaying of lists and authorizing a line item transaction (col 24, lines 45-67; col 25, lines 1-25), line item payment authorization of receiving selection of at least one line item and form of payment and authorizing a transaction by EFT and check (col 38, lines 60-63), date range for which payment will be made (col 36, lines 18-65), payment frequency and number of payments (col 8, lines 28-33), receiving new vendor identifying information, receiving vendor authorization data, and incorporating the new vendor into the database (col 32, lines 1-19),

It would have been obvious to one with ordinary skill in the art to include "preferred" (exceptional) vendors, vendor performance, payment only when "preferred" status because Murcko, Jr teaches services rendered only for exception service (col 24, 45-67).

It would have been obvious to one with ordinary skill in the art to include correspondence with at least one line item regarding displaying of lists and authorizing a line item transaction because Murcko, Jr teaches specific service rendered for specific payment rendered (col 24, lines 45-67).

It would have been obvious to one with ordinary skill in the art to include line item payment authorization of receiving selection of at least one line item and form of payment and authorizing a transaction by EFT and check because Murcko, Jr teaches payment needed for revenue stream (col 37, lines 64-65).

It would have been obvious to one with ordinary skill in the art to include date range for which payment will be made because Murcko, Jr teaches payments are known to be delayed (col 36, lines 25-35).

It would have been obvious to one with ordinary skill in the art to include payment frequency and number of payments because Murcko, Jr teaches quality measurement linked to frequency (col 8, lines 28-30).

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It would have been obvious to one with ordinary skill in the art to include receiving new vendor identifying information, receiving vendor authorization data, and incorporating the new vendor into the database because Murcko, Jr teaches buyers of services require seler information (col 32, lines 15-20).

8. Claims 10, 24, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al in view of McLauchlin et al in further view of Murcko, Jr. as applied to claims above, and further in view of DiRienzo et al.

Borghesi et al do not disclose electronic fund transfer.

DiRienzo et al discloses a method, system, and medium for evaluating line item data, including payment by check and electronic funds transfer (e.g., column 22, line 12 et seq). Electronic funds transfer provides a well-known equivalent means of settling claims (e.g., column 22, line 16 et seq).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide for claim adjudication and settlement via electronic funds transfer, in addition to payment by check, as taught by DiRienzo et al, on the method, system, and medium of Borghesi et al for the purposes of facilitating a claim settlement (e.g., to expedite settlement).


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alain L. Bashore
Primary Examiner
Art Unit 3624